Application No.: 09/848,255 Docket No.: 21919-00013-US

## REMARKS

Bearing in mind the comments in the Final Official Action, the Advisory Action, and the arguments presented in this amendment accompanying the Request for Continued Examination (RCE), the application is believed to be in condition for allowance. An early indication of the same would be appreciated.

Claims 1-8 are now pending in this application. Claims 1 and 6 are independent. Claim 1 has been amended, and claims 2-8 have been added by this amendment. No new matter is implicated by any claim amendment or new claim.

Withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over Razeto et al. (US 4,748,904) in view of Clemes (US 5,106,596) is requested. Applicant submits that there is improper motivation to combine the references in the manner suggested by the Examiner, particularly considering that the disclosure of Razeto et al. specifically teaches away from at least one aspect of the claimed invention.

At the outset, Applicant notes that, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference must teach or suggest all the claim limitations.***[1] Further, ***the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.***[2]

An essential evidentiary component of an obviousness rejection is a teaching or suggestion or motivation to combine the prior art references.[3] Combining prior art references

[1] *See* MPEP §2143.
[2] *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and *See* MPEP §2143.
[3] *C.R. Bard, Inc. v. M3 Systems, Inc.*, 48 USPQ2d 1225 (Fed. Cir. 1998)

without evidence of a suggestion, teaching or motivation simply takes the inventors' disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.[4]

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art."[5] Further with regard to the level of skill of practitioners in the art, there is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.[6] The level of skill in the art cannot be relied upon to provide the suggestion to combine references.[7]

Further evidence that there is insufficient motivation to combine Razeto et al. and Clemes (Applicant's own work) is that the primary reference to Razeto et al. itself teaches away from the combination suggested by the Examiner. References teach away from a combination when the combination would produce a seemingly inoperative device.[8] If the teachings of a prior-art reference would lead one skilled in the art to make a modification that would render another prior-art device inoperable (or unsuitable for a stated purpose), such a modification would generally not be obvious.[9]

It is impermissible within the framework of 35 U.S.C. §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.[10] Further in this regard, As the Court of Customs and Patent Appeals, predecessor to the Federal Circuit, has held:

> All relevant teachings of cited references must be considered in determining what they fairly teach to one having ordinary skill in the art. The relevant portions of a reference include not only those teachings which would suggest

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[4] *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (Fed. Cir. 1985)
[5] *See* MPEP §2143.01, citing *In re Rouffet*, 149 F.3d, 1350, 1357, 47 USPQ2d 1453, 1457-8 (Fed. Cir. 1998).
[6] *Ex parte Gerlach and Woerner*, 212 USPQ 471 (PTO Bd. App. 1980).
[7] *See* MPEP §2143.01, citing *Al-Site Corp. v. VSI Int'l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999).
[8] *In re Sponnoble*, 160 USPQ 237, 244 (CCPA 1969).
[9] *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).
[10] *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416 (Fed. Cir. 1986).

> particular aspects of an invention to one having ordinary skill in the art, but also those teachings which would lead such a person away from the claimed invention.[11]

The rejections in the Official Action amount, in substance, to nothing more than hindsight reconstruction of Applicant's invention by relying on isolated teachings of the applied art, without considering the overall context within which those teachings are presented. Without benefit of Applicants' disclosure, a person having ordinary skill in the art would not know what portions of [Razeto et al. and Clemes] to consider, and what portions to disregard as irrelevant or misleading.[12]

Applicant's claimed invention is directed to a ***sulphur dioxide generator*** which might find application in, for example, the shipment of grapes or other fruits or vegetables subject to spoilage by fungi.

Razeto et al., is directed to a ***chlorine generator*** which also purports to overcome spoilage problems with fruits and vegetables in transit.

***However, Razeto et al. specifically disfavors the use of sulphur dioxide generators for fruit and vegetable shipment, as stated at col. 1, lines 10-14.*** The disclosure of Razeto et al. is set forth as solving a known problem with sulphur dioxide generators, and specifically chooses chlorine dioxide, and ***not*** sulphur dioxide, as in Applicant's claimed invention.

Applicant submits that this portion of the disclosure of Razeto et al. may not fairly be ignored by the Examiner in formulating a rejection for unpatentability, particularly in setting forth the required motivation to modify the disclosure of Razeto et al. by the teaching of Applicant's own work, i.e., the secondary reference to Clemes.

The Federal Circuit case law cited above is clear in this regard – there is no motivation found in the applied art to modify Razeto et al. in the manner suggested.

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[11] *In re Mercier*, 185 USPQ 774, 778 (CCPA 1975).
[12] *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965).

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Therefore, Applicant submits that a person having skill in the art would not be motivated to modify Razeto et al. to generate sulphur dioxide, given the technical problem solved by Razeto et al., in light of the specific teaching away by Razeto et al. of the use of sulphur dioxide.

Accordingly, withdrawal of the rejection and allowance of claim 1 is requested. Claim 1 has been amended for format purposes only, and not in any attempt to overcome any art of record.

Consideration and allowance of newly presented claims 2-8 are requested. These claims have been drafted to further define that which Applicant regards as his invention. No new matter is involved with any new claim.

In view of the above, each of the presently pending claims 1-8 in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

An Information Disclosure Statement (IDS) is being concurrently filed by separate correspondence.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 21919-00013-US from which the undersigned is authorized to draw.

Respectfully submitted,

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